

**THIS DISPOSITION  
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THE TTAB**

Mailed: April 20, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Encompass Group, LLC<sup>1</sup>

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Serial No. 76311395

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Robert B. Kennedy of Baker, Donelson, Bearman & Caldwell for  
Encompass Group, LLC.

Kathleen M. Vanston, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

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Before Quinn, Walters and Kuhlke, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Encompass Group, LLC has filed an application to  
register on the Principal Register the mark SILK EASE, in  
standard character form, for "health care apparel worn by  
professional medical personnel, namely, scrub suits and  
examination gowns," in International Class 10.<sup>2</sup> The

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<sup>1</sup> The assignment records of the USPTO show that this application has  
been assigned to Wachovia Bank.

<sup>2</sup> Serial No. 76311395, filed September 10, 2001, based on an allegation  
of a bona fide intention to use the mark in commerce.

application includes a disclaimer of SILK apart from the mark as a whole.

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is deceptively misdescriptive in connection with its goods, and under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that applicant's mark is deceptive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

The refusals are based on the examining attorney's allegation, not disputed by applicant, that the goods to be identified by the mark will not contain silk. The examining attorney states that silk is a fabric and that silk and silk blends are often used in the production of clothing in general and scrubs in particular. She contends that the mark SILK EASE, if used in connection with the identified goods, will convey the impression that the goods are made of silk, not that the goods merely have a "silky" feel. The examining attorney argues that because applicant's goods do not contain silk fibers, SILK EASE misdescribes the identified garments, noting that washable silk is a relatively new product that is desirable in clothing, particularly casual clothing, because of its ease of care and comfort; that the strength, comfort and durability of

garments made of silk blends would make those blends suitable for a hospital environment; that consumers, including consumers purchasing health care apparel, are likely to believe that SILK EASE scrub suits and examination gowns made of a soft fabric actually contain silk; and that, in view thereof, whether the identified goods contain silk is likely to materially affect the decision to purchase these types of goods.

In support of her position, the examining attorney submitted a definition of "silk" from *The American Heritage Dictionary of the English Language*, 4<sup>th</sup> ed. 2000 (www.dictionary.com)<sup>3</sup>; excerpts of Internet websites; excerpts of articles retrieved from the LEXIS NEXIS database; and copies of third-party registrations wherein the marks contain the term "silk," the identified goods are made in whole or part of silk, and the term "silk" is disclaimed.

The examining attorney alleges that the prior case of *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (SILKEASE found to be deceptive in connection with women's clothing, namely, women's blouses and ladies dresses made of polyester crepe de chine) is analogous to the case before us. She also

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<sup>3</sup> "n. 1. a. A fine lustrous fiber composed mainly of fibroin and produced by certain insect larvae to form cocoons, especially the strong, elastic, fibrous secretion of silkworms used to make thread and fabric. b. thread or fabric made from this fiber. c. a garment made from this fabric. ... adj. Composed of or similar to the fiber or the fabric silk."

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references *In re Phillips-VanHeusen Corp.*, 63 USPQ2d 1047 (TTAB 2002), wherein the Board found SUPER SILK to be deceptive in connection with shirts made of a silk-like fabric, but not containing silk as a component.

The excerpted Internet websites include the home page for Jasco Uniform Co. ([www.jascouniform.com](http://www.jascouniform.com)) with a box containing links to descriptions of their various types of scrubs, including "Soft and Cheap Scrubs," "Denim Scrubs," and "Silk and TieDye Scrubs." The latter links to a page that includes the heading "Soft as Silk Scrubs," with the following description: "Feels like silk with a no care silk-like fabric. It's like wearing pajamas. Available in 5 prints & colors." One of the Internet websites, [www.nursesdirect.com](http://www.nursesdirect.com), advertised applicant's garments with the following description:

SCRUB JACKET offers the perfect combination of style and silky soft comfort. Microfiber polyester.  
SILK EASE™ SCRUB SEPARATES These microfiber polyester scrubs are oh-so-soft and comfortable. ...

The examining attorney contends that scrub suits and examination gowns may, in fact, be made of silk. One of the Internet websites, [www.scrubsgallery.com](http://www.scrubsgallery.com), includes the following item for sale:

Annika  
Cherokee Nursing uniforms & scrubs: Styles: NEW  
MICA SILK #2700 XS - 3X & 350E XS - 3X. ...

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An excerpt from the Daily News Record (August 14, 1998), retrieved from the LEXIS NEXIS database includes the following statement:

Pieces range from woven and knit separates to robes, boxers and even kimonos and gid (short kimonos). Shown here are the silk/cotton blend scrub shirt and drawstring pant.

The Internet evidence also includes the results of a Google search of "silk clothing" listing numerous sites advertising silk clothing; the results of a Google search for "silky feel" listing numerous sites using the phrase to describe various goods including clothing, hosiery, pet collars, bedding and skin care products; and the results of a Google search for "silky scrubs" listing a few websites advertising various brands of scrubs, including the brand "Silky Scrubs."

Also from the Internet, the examining attorney submitted excerpts of websites indicating that silk fibers may be blended with other fibers, such as cotton or wool, to create blended fabrics.

Articles made of record from the LEXIS NEXIS database demonstrate the wide variety of uses for silk fabric and fibers, from clothing to medical and industrial uses, and reference the characteristics and popularity of washable silk fabric. Silk is described as a fiber that is extremely strong and resilient, with insulating properties.

Applicant contends that the term "silk" in its mark is suggestive of a quality of its scrub suits and examination gowns, quoting a definition of "silky" from *Random House Dictionary* as "of or like silk; smooth, lustrous, soft, or delicate: silky skin"; that the second term in the mark, "ease," reinforces the suggestive connotation of "silk" as "soft"; and that the professional and institutional buyers of applicant's goods would not view the mark as connoting the material from which the goods are made because silk is not suitable for use on clothing required in the medical environment.

Applicant contends that its mark is suggestive of a trait of its goods, namely, that the scrub suits and examination gowns have a "silky" feel; that the pronunciation of its mark, SILK EASE, with the long "e" sound immediately following the "k" in "silk," leads the speaker to hear the term "silky", supporting this connotation of "silk" in applicant's mark as the feel of the fabric; that the addition of the term "ease" to the term "silk" in its mark "guide[s] the meaning or connotation of the mark to that of 'silky' for it suggests a smooth, soft or delicate feel" (brief, p. 2).<sup>4</sup>

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<sup>4</sup> Applicant mentions Registration No. 2028553 for the mark SILKEASE, purportedly for washing compound, arguing that it clearly suggests a silky feel. Applicant did not submit a copy of this registration and, thus, it is of limited value. Moreover, applicant's statements regarding the connotation of the registered mark are mere speculation.

Applicant seeks to distinguish the Board's decision in *In re Shapely, Inc., supra*, on the ground that the identified goods therein, women's blouses and dresses made of polyester crepe de chine, are goods that are commonly made of silk, whereas, its scrub suits and examination gowns are *not* the type of goods that would be made of silk; and, unlike the case now before us, the mark in *Shapely* was in a design format and the Board noted the dominance of the term "silk" in that design.

We begin by considering whether the proposed mark, SILK EASE, is deceptively misdescriptive in connection with the identified goods, "health care apparel worn by professional medical personnel, namely, scrub suits and examination gowns." The inquiry is twofold. First, we must determine whether the proposed mark misdescribes a characteristic, quality, function, composition or use of the goods. If so, we must determine whether prospective purchasers are likely to believe that the misdescription actually describes the goods. The burden is on the Examining Attorney to submit sufficient evidence to establish that the term sought to be registered falls within the proscription of the statute. *In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993) citing *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988). In other words, to consider whether the mark is deceptively misdescriptive

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under Section 2(e)(1), we consider the first two factors in the three-part test, noted below, for determining whether a mark is deceptive under Section 2(a) enunciated by the Court of Appeals for the Federal Circuit in *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (1988):

1. Is the term misdescriptive of the character, quality, function, composition or use of the goods?
2. If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
3. If so, is the misdescription likely to affect the decision to purchase?

See also, *In re Woolrich Woolen Mills, Inc.*, 13 USPQ2d 1235 (TTAB 1989).

*Does the mark misdescribe the goods?*

The evidence establishes that clothing is often made of silk or silk blend fabrics, that at least some scrubs are made of fabric containing silk, and that the identified scrubs and gowns are not made of silk.

Other than argument and dictionary definitions, *supra*, applicant has provided little basis for us to conclude that "silk" in SILK EASE connotes the feel of a fabric, rather than the fiber itself. The term used is "silk" not "silky"; and it is the term "silky" that would be likely to connote the feel of the fabric. We are not persuaded that purchasers would perceive of the term "silk" in the mark as "silky" because of the long "e" at the beginning of the word

"ease" that follows. The additional word "ease" in the mark does not detract from the meaning of silk as a fabric when considering the mark as a whole. We take judicial notice of the definition of "ease" as, in relevant part, "a state of comfort"<sup>5</sup> and, thus, conclude that "ease" would be likely to be perceived in the mark as suggesting comfort rather than the feel of the fabric. Therefore, we conclude that the mark misdescribes the goods because it connotes comfortable scrubs and examination gowns made of silk.

*Are consumers likely to believe the misrepresentation?*

The mark must misdescribe the goods in such a manner that consumers would be likely to believe the misrepresentation. *In re Quady Winery, Inc.*, 221 USPQ 1213, 12 14 (TTAB 1984).

The evidence clearly establishes that consumers are used to seeing all types of clothing made of silk and silk blends and that silk blends and washable silks are strong, washable and comfortable. There are two website excerpts in the record indicating that there are scrubs on the market made of silk or silk blends, as well as scrubs made of silky-feeling fabrics. Further, there is no evidence that scrubs worn by medical personnel and examination gowns are not or should not be made of silk or silk blends. There is also evidence, as noted *supra*, that fabrics containing silk

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<sup>5</sup> *Webster's II New Riverside University Dictionary*, 1984.

are both comfortable and durable and that these are desirable qualities in, at least, scrubs. It is reasonable to assume that buyers of scrubs for medical personnel and examination gowns would encompass a wide range of types of buyers, including small medical practices and large institutions, as well as individual medical technicians, nurses and doctors. Thus, the sophistication of such purchasers is likely to vary widely. We find that this class of reasonably prudent buyers is likely to believe that scrubs and examination gowns identified by the mark SILK EASE are made of fabric that includes silk.

Having met the first two prongs of the *Budge* test, we conclude that the mark SILK EASE is deceptively misdescriptive in connection with the identified goods.<sup>6</sup> We now turn to the question of whether the mark is also deceptive.

*Will the misrepresentation materially affect the decision to purchase?*

As noted above, it is reasonable to assume that comfort is a desirable characteristic of the identified goods. Further, several of the excerpts in the record tout the

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<sup>6</sup> We note that even if the nature of the goods is revealed by matter on labels on the goods themselves, this does not preclude a determination that a mark is deceptively misdescriptive. See *Tanners' Council of America, Inc. v. Samsonite Corporation*, 204 USPQ 150 (TTAB 1979) ("We are not persuaded, therefore, that the labels identifying the material as 'urethane vinyl' dispel the impression that respondent's goods are made of leather."), citing *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (CCPA 1964). Thus, applicant's argument is not well taken.

comfort and feel of the scrubs being advertised. This evidence is sufficient to establish that the qualities of silk fibers in fabrics used in scrubs and examination gowns would be attractive to prospective purchasers and would materially affect the purchasing decision. Thus, we conclude that the mark SILK EASE is deceptive in connection with the identified goods.

We note that, while we have reached the same conclusion of deceptiveness herein as we did in *Shapely, supra*, our decision in this case is based on a different set of facts. Materiality was found in *Shapely* based on the prominence of the term SILK in the composite design mark and advertising copy promising "the look and feel of the finest silks" on the garment hangtag, which was the specimen of record and only evidence in the file.

*Decision:* The refusal under Section 2(e)(1) of the Act is affirmed. The refusal under Section 2(a) of the Act is affirmed.